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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR                          | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---|---------------------|------------------|
| 10/708,378      | 02/27/2004  | Huiliang Zhu                                  | FIS920030371US1     | 2377             |
| 30743           | 7590        | 09/11/2006                                    |                     | EXAMINER         |
|                 |             | WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. |                     | NGO, NGAN V      |
|                 |             | 11491 SUNSET HILLS ROAD                       |                     |                  |
|                 |             | SUITE 340                                     | ART UNIT            | PAPER NUMBER     |
|                 |             | RESTON, VA 20190                              |                     | 2818             |

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 10/708,378      | ZHU ET AL.   |
|                              | Examiner        | Art Unit     |
|                              | Ngan Ngo        | 2818         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 11 July 2006.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-15 and 21-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5, 10, 11, 15 and 21-25 is/are rejected.

7) Claim(s) 6-9 and 12-14 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    Paper No(s)/Mail Date. \_\_\_\_\_.  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_                    5) Notice of Informal Patent Application (PTO-152)  
 \_\_\_\_\_                    6) Other: \_\_\_\_\_

The amendment filed July 11, 2006 has been entered and made of record as paper no. 0706.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Krivokapic et al.

Krivokapic discloses a field effect transistor comprising a gate structure (42) and a discontinuous film (30) of material within layer of semiconductor material (14) and having a discontinuity aligned with the gate structure.

In re claim 2, Krivokapic also discloses the self-aligned method but no patentable weight is given to the method of making a semiconductor device in claims drawn to structure. A "product by process" claim is directed to the product *per se*, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17(footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product *per se* which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a

product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear.

In re claims 3 and 4, the insulator film (30) in Krivokapic can inherently be a stressed film.

In re claim 21, Krivokapic clearly show the discontinuous film (30) having an edge located in a position defined by an edge of the gate structure. The discontinuity of the film (30) clearly define a depth of a conduction channel within the layer of the semiconductor material to less than the predetermined distance from the surface of the semiconductor material and inherently have stress to the conduction channel.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Krivokapic et al in view of Bae.

Krivokapic discloses all the subject matter discussed above. However, Krivokapic does not disclose about void formed in the semiconductor material. Bae disclose a field effect transistor having void (35) formed in the semiconductor material to suppress floating body effects. Note that void is also formed in porous silicon 23b in Bae. Therefore, it would have been obvious to one of ordinary skill in the art to form void in the semiconductor material in Krivokapic in order to suppress floating body effects as taught by Bae.

Claims 6-9, 12, 13 and 14 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed July 11, 2006 have been fully considered but they are not persuasive.

The "self-aligned" method is taught by Krivokapic. Figures 5 and 6 of Krivokapic clearly show the discontinuous film 30 formed in alignment with the gate structure 42.

Since only alleged distinction between the applicant's and reference is recited in functional language, it is incumbent upon applicant, when challenged, to show that device disclosed by reference does not actually possess such characteristics. See In re Ludtke, 169 USPQ 563. Patent office possesses authority to require applicant to prove that subject matter shown to be in prior art does not possess characteristics relied on. See In re Swinehart, 169 USPQ 226.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Ngan Ngo at telephone number (571) 272-1711. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature consisting of the initials 'N' and 'V' with a checkmark in the middle.

Ngan Van Ngo  
Primary Examiner

Ngan Ngo  
August 26, 2006